

Appl. No. 10/501,553
Amendment dated December 27, 2005
Reply to Office Action of October 6, 2005

REMARKS

In the October 6, 2005 Office Action, all of the claims stand rejected in view of prior art. No other objections or rejections were made in the Office Action.

Status of Claims and Amendments

In response to the October 6, 2005 Office Action, Applicants have amended the claims as indicated above. Thus, claims 1-9 are pending, with claims 1, 8 and 9 being the only independent claims. Reexamination and reconsideration of the pending claims are respectfully requested in view of above amendments and the following comments.

Interview Summary

On November 16, 2005, the undersigned conducted a personal interview with Examiner West, who is in charge of the above-identified patent application, and Examiner Williams. During the interview, the limitations of the claims as they relate to the prior art was discussed. Examiner West indicated that adding a limitation that states the check tool is applied inside of the refrigerant line or equipment would distinguish over the prior art of record. Applicants wish to thank Examiners West and Williams for the opportunity to discuss the above-identified patent application during the Interview of November 16, 2005.

July 16, 2004 Information Disclosure Statement

An Information Disclosure Statement was submitted on July 16, 2004. As of the date of this response, Applicant has not received a signed and initialed copy of the 1449 form. Applicant respectfully requests a signed and initialed copy of the 1449 form with the next office communication.

Rejections - 35 U.S.C. § 103

Claims 1-9 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,831,144 (Pastorello) in view of alleged admitted prior art and further in view of

U.S. Patent No. 4,248,597 (McNeely). In response, Applicants have amended independent claims 1, 8 and 9 to clearly define the present invention over the prior art of record.

More specifically, independent claims 1, 8 and 9 now clearly recite that the check tool is applied inside the refrigerant using equipment or the refrigerant lines. This arrangement is *not* disclosed or suggested by the above combination or any other prior art of record. It is well settled in U.S. patent law that the mere fact that the prior art can be modified does *not* make the modification obvious, unless the prior art *suggests* the desirability of the modification.

Pastorello discloses a glass tube that is to be used in conjunction with a tube holding device described in U.S. Patent No. 5,419,177 (see, for example, column 5, lines 48-50 of Pastorello). “A sample of the lubricant to be tested is passed into the glass tube....” (see Abstract of Pastorello.) Thus, Pastorello discloses *removal* of oil to test for contamination and therefore does not meet the limitations of claim 1.

Independent claim 1 requires that residual material, which remains inside the refrigerant using equipment or refrigerant lines, be applied to a check tool. The check tool is applied inside the refrigerant using equipment or the refrigerant lines. In contrast, Pastorello discloses taking a sample out of the refrigerant using equipment and placing it into a glass tube.

The alleged admitted prior art and McNeely do not remedy the deficiencies of Pastorello. The alleged admitted prior art and McNeely do not disclose applying residual material that remains inside of the refrigerant using equipment or the refrigerant lines to a check tool. Furthermore, the alleged admitted prior art and McNeely do not disclose a check tool that is applied inside the refrigerant using equipment or the refrigerant lines.

Accordingly, because the combination rejection does not teach or suggest all of the claimed limitations, a *prima facie* case of obviousness has not been established.

Moreover, Applicant believes that the dependent claims are also allowable over the prior art of record in that they depend from independent claim 1, and therefore are allowable for the reasons stated above. Thus, Applicant believes that since the prior art of record does not disclose or suggest the invention as set forth in independent claim 1, the prior art of record also fails to disclose or suggest the inventions as set forth in the dependent claims.

In addition, the dependent claims are further allowable because they include additional limitations. For example, Pastorello does not teach the limitations of dependent claims 4 and 5 and independent claims 8 and 9. Pastorello teaches a series of colors indicating specific thresholds of contamination (see generalized chart at bottom of column 4). However, the generalized chart does not teach a boundary color that indicates a boundary at which cleaning is necessary when using the refrigerant using equipment or the refrigerant lines. Each of the colors in the generalized chart of Pastorello may not be the boundary that indicates cleaning is necessary. Therefore, the boundary color cannot be determined from the generalized chart of Pastorello. Thus, if a user uses the generalized chart of Pastorello, it will be difficult to determine a need for cleaning.

If the user uses the claimed method, the user can compare the color of the first means or section to which impurities have been applied with the boundary color of the second means or section. Thus, it is easy for the user to determine a need for cleaning when using refrigerant using equipment or refrigerant lines.

Applicant respectfully requests that the rejection be withdrawn in view of the above comments and amendments.

Appl. No. 10/501,553
Amendment dated December 27, 2005
Reply to Office Action of October 6, 2005

Conclusion

In view of the foregoing amendment and comments, Applicants respectfully assert that claims 1-9 are now in condition for allowance. Reexamination and reconsideration of the pending claims are respectfully requested.

Respectfully submitted,


David J. McCroskey
Reg. No. 56,232

SHINJYU GLOBAL IP COUNSELORS, LLP
1233 Twentieth Street, NW, Suite 700
Washington, DC 20036
(202)-293-0444

Dated: December 27, 2005

G:\12-DEC05-KK\DK-US020066 Amendment.doc